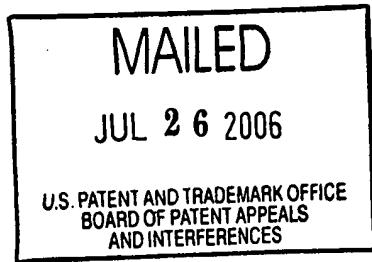


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DOMINICK CIRONE



Appeal No. 2006-1395  
Application No. 10/687,875

HEARD: JUNE 6, 2006

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 19 and 20, which are all of the claims pending in this application. Claims 1 to 18 have been cancelled.

The appellant's invention relates to a protective bat barrel cover for a baseball or softball bat (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The Prior Art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Zills	4,401,245	Aug. 30, 1983
Millis et al. (Mills)	4,989,811	Feb. 5, 1991
Block	5,163,608	Nov. 17, 1992
Jones	5,417,354	May 23, 1995
Moseley	6,065,764	May 23, 2000
Cirone	6,681,821	Jan. 27, 2004

The Rejections

Claim 19 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,681,821 to Cirone.

Claim 20 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,681,821 to Cirone in view of U.S. Patent No. 5,417,354 to Jones.

Claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zills in view of Millis.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zills in view of Millis and further in view of Block or Moseley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed April 7, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 12, 2005) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant has made no arguments regarding the rejections of claims 19 and 20 under the judicially created obviousness-type double patenting doctrine but rather states that upon indication of allowable subject matter, the appellant will file a terminal disclaimer to obviate the rejections. As appellant has made no arguments regarding these rejections, we will summarily sustain these rejections.

We turn next to the examiner's rejection of claim 19 under 35 U.S.C. § 103 as being unpatentable over Zills in view of Millis. In support of this rejection, the examiner states:

Zills teaches a cover having a first piece of material having first and opposing second edge fastened to form a tubular casing at portion 28 as shown in Fig. 1, and a second end closed off by a second piece at portion 16 as shown in Fig. 2. Note the edge about portion 28 is partially fastened to form a slit at portion 26, and fastening means at portion 30. Zills meets all claimed limitations except for the material being neoprene. Millis teaches that it is known in the art to make a cover from neoprene material (col. 3, lines 60). It would have been obvious to one of ordinary skill in the art to make the cover from neoprene material in Zills as taught by Millis to provide an alternative material for insulation or other properties [answer at page 4].

In regard to the recitation in the preamble of claim 19 of a cover for a baseball or softball bat, the examiner is of the opinion that this language is directed to intended use only.

We do not agree with the examiner that the language in the preamble of claim 19 regarding a cover for a baseball or softball bat is merely language of intended use.

The question of whether a preamble constitutes a limitation to a claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. See In re Stencil, 828 F.2d 751, 754, 4 USPQ2d 1071, 10 question of 73 (Fed. Cir. 1987). The preamble of a claim does not limit the scope of the claim when it merely states intended use of the invention. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). However, terms in a preamble are construed as limitations when

they give life and meaning to the invention claimed. Gerber Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 688, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990)(quoting) Perkins-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857(1984). Although no "litmus test" exists as to what effect should be accorded to terms appearing in a preamble, a patent application in its entirety should be reviewed to determine whether the inventors intended such language to represent additional limitations or mere introductory language. See, e.g., In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673-74 (Fed. Cir. 1994)(citing Corning Glass Works v. Sumitomo Elect. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)).

In the present case, the entire patent application is directed to a cover for a baseball or softball bat. In addition, the body of the claim recites elements in relationship to a baseball or softball bat. In this regard, claim 19 recites (1) the first piece of neoprene has a first open end for receiving a barrel portion of the bat, (2) a tubular casing adapted to cover substantially only the barrel portion of the bat and (3) a fastening means for securing a cover to the barrel portion of the bat. Therefore, in our view, the language in the preamble of a cover for a baseball or softball bat breathes life and meaning into the claim and must be considered when determining patentability.

We will not sustain this rejection as we agree with the appellant that the prior art references applied are not analogous art. The test for non-analogous art is first whether

the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

In the present case, we are informed by the appellant's originally filed specification that the invention is particularly directed to a cover for a baseball or softball bat and Zills and Millis relate to covers for beverage containers and thus are outside the field of the appellant's invention i.e. a cover for a baseball or softball bat. In addition, as the problem addressed by the appellant's invention, i.e. protecting a baseball or softball bat from sunlight, heat, moisture and general inclement weather (see specification at page 1), is not discussed in either Zills or Millis, these references would not have commended themselves to an artisan's attention in considering the appellant's problem. Thus, we conclude that Zills and Millis are not analogous art.

In view of the foregoing, we will not sustain the examiner's rejection of claim 19.

We turn next to the examiner's rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over Zills and Millis as applied to claim 19 and further in view of Block or Moseley. Claim 20 differs from claim 19 in that claim 20 recites that the bat cover is comprised of elastic rubber rather than neoprene and also includes a graphic displayed

on the tubular casing. The examiner has relied on Block or Moseley for the teaching of the graphic display on the cover.

We will not sustain this rejection because claim 20 contains the same language as claim 19 regarding a protective bat barrel cover for a baseball or softball bat in the preamble and the body of the claim and thus we are of the opinion that the preamble of claim 20 breathes life and meaning into the claim in the same manner as discussed above for claim 19. As stated above, Zills and Millis are not analogous art to the subject matter of claim 20. In addition, Moseley relates to a sanitary cover for a shopping cart handle and Block relates to a combination postcard/container insulator for a beverage container and as such are neither in the field of baseball or softball bat covers nor are they pertinent to the problem of protecting a baseball or softball bat, they too are not analogous art.

In summary:

The examiner's rejections of claims 19 and 20 under the judicially created doctrine of obviousness-type double patenting are sustained. The examiner's rejections of claims 19 and 20 under 35 U.S.C. § 103 are not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(1)(iv).

AFFIRMED

*Charles E. Frankfort*  
CHARLES, E. FRANKFORT  
Administrative Patent Judge

*Muriel E. Crawford*  
MURRIEL, E. CRAWFORD  
Administrative Patent Judge

*Jennifer D. Bahr*  
JENNIFER, D. BAHR  
Administrative Patent Judge

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